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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,741	03/22/2001	Bruno Messmer	1141188-3/DU	6555
22850 7590 05/04/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PHAN, JOSEPH T	
			ART UNIT 2614	PAPER NUMBER
			NOTIFICATION DATE 05/04/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/787,741	<b>Applicant(s)</b> MESSMER, BRUNO	
	<b>Examiner</b> Joseph T. Phan	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-35, 37-40 and 44-46 is/are allowed.
- 6) ☒ Claim(s) 36, 41, 42 and 47 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36, 41-43, and 47 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 36, 41-43, and 47 recite "a computer-readable data carrier comprising a computer program" which is non-statutory subject matter. The term "data carrier" could be interpreted as a signal, waveform, etc. and a "computer program" is non-statutory which makes the claims indefinite.

Appropriate clarification and/or correction are required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 36 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 lines 15-16 recites "editing the list assigned to the transmitting subscriber by the transmitting subscriber using speech recognition by means of spoken language". This phrase is unclear and confusing as it is not known if the transmitting subscriber assigns the list to himself and whether he/she uses speech recognition to 'assign'. Appropriate clarification and/or correction is required.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 36, 41-42, and 47 rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg, Patent #6,075,844 in view of Culbreth et al., Patent #5,953,393.**

**Regarding claim 36 Goldberg** teaches as best understood due to the 112 confusion above, a computer-readable data carrier connected to a public switched telephone network including a plurality of subscribers comprising:

a computer program to be executed by a processor controlling a message exchange connected to a telephone network having a plurality of subscribers, wherein when said computer program is executed, the message exchange performs steps including, storing a plurality of lists with subscriber identifications, each identification containing a subscriber identifier and a corresponding reference number, and each list being assigned to at least one of the subscribers (124 fig.1, col.5 lines 32-54, and col.9 lines 5-12)

receiving a spoken message from one of the subscribers in the telephone network via the telephone network, the one of the subscribers being a transmitting

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subscriber, and to store the spoken message with an identification of the transmitting subscriber(Fig.1, col.4 lines 29-46, and col.5 lines 15-31);

a speech recognition module configured to enable the transmitting subscriber to designate by means of spoken language at least one of the other subscribers as an addressee to whom the spoken message is addressed (Fig.1,col.3 lines 55-65 and col.4 lines 20-28) and

editing the list assigned to the transmitting subscriber by the transmitting subscriber using speech recognition by means of spoken language(*col.6 lines 9-34 and col.7 lines 60-67; "by means of spoken language" can be read as the means(system) used to speak, does not have to require speech recognition*).

enable the transmitting subscriber to designate by means of spoken language at least one of the other subscribers as an addressee to whom the spoken message is addressed(Fig.1,col.3 lines 55-65 and col.4 lines 20-28);

transmitting by means of an automatic call the spoken message to the addressee(col.5 lines 32-40).

Goldberg does not expressly disclose inquiring if a reply is to be sent from the addressee to the transmitting subscriber and a reply module configured to receive and to store the reply from the addressee but does disclose prompting the recipient the capability of the system to receive a reply(col.4 lines 51-54 and col.7 lines 1-28).

Culbreth discloses inquiring if a reply is to be sent from the addressee to the transmitting subscriber and a reply module configured to receive and to store the reply from the addressee (130 Fig.1, 230 Fig.2, and col.4 line 35-col.5 line 49).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Goldberg to include Culbreth's means and method of receiving and storing a reply from the addressee as taught(col.4 line 35-col.5 line 49).

One of ordinary skill in the art would have been motivated to do this as Goldberg already establishes a system that is capable of sending a message and insinuates discussing a matter further(col.4 lines 51-54) and Culbreth merely furthers this insinuation as a reply from the recipient(Fig.1 and col.4 line 35-col.5 line 49) and therefore easily motivated to modify Goldberg's prompting system.

Regarding claim 41, Goldberg in view of Culbreth teaches the computer-readable data carrier of claim 36, wherein when said computer program is executed, the message exchange further performs: determining an identification of the transmitting subscriber(col.7 lines 1-65 and col.9 lines 5-12).

Regarding claim 42, Goldberg in view of Culbreth teaches the computer-readable data carrier of claim 36, wherein when said computer program is executed, the message exchange further performs: determining one of the plurality of lists that corresponds to the transmitting subscriber based on the identification of the transmitting subscriber(col.7 lines 1-65 and col.9 lines 5-12).

Regarding claim 47 Goldberg in view of Culbreth teaches a computer-readable data carrier according to claim 36, wherein the reply module to receive the reply from the addressee is sent by the addressee by means of spoken guidance(col.7 lines 1-65

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and col.9 lines 5-12).

***Allowable Subject Matter***

4. Claims 19-35, 37-40, and 44-46 allowed. Among other features, the prior art of record does not teach the newly amended claims.

***Response to Arguments***

5. Applicant's arguments with respect to claims 19-47 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTP

April 27, 2007



**CREIGHTON SMITH  
PRIMARY EXAMINER**